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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,575	03/15/2001	Borislav Bogdanovic	Studien 280-KGB	5896

7590 03/31/2003

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EXAMINER

VOLLANO, JEAN F

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 03/31/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,575

Applicant(s)

BOGDANOVIC ET AL.

Examiner

Jean F. Vollano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 15-25 is/are rejected.
- 7) ☒ Claim(s) 10-14 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

1. The amendment , the RCE and the IDS filed 3/3/2003 has been entered. Claims 1-24 and newly added claim 25 are pending.
2. The amendments have specifically set out that there is a second metal containing compound , said second metal containing compound must increase the activity of the transition metal catalyst. Applicant has stated this is a new limitation that is required of the second metal containing compound and that is that it must increase the activity of the transition metal. There is not limitation on the quantity needed to activate the transition metal catalyst and as such and until demonstrated to be otherwise this reads on any quantity of the second metal containing compound. The one exception is that there is a teaching in the specification that a few drops of ethyl bromide would not make enough EtMg Br to increase activity of the catalyst and so for that teaching there is a showing that it does not activate the catalyst.
3. Since the specification teaches that a few drops of ethyl bromide would not make enough EtMg Br to increase activity of the catalyst and therefore the 102(b) and 103(a) rejection over Bogdanovic (DE19628159) and the secondary references in the 103(a) rejection are withdrawn.
4. The 35 USC 112, paragraph 2 rejections are withdrawn. Upon review of the amendment and applicants arguments the rejection under 35 USC 112, first paragraph is withdrawn.

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5. The rejection of claims 1, 3-5, 8-9, 16 and additional claim 25 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 6 of U.S. Patent No. 6,117,372 is maintained.

Claim 1 contains comprising language and Claim 2 of the US patent claims a metal selected from the periodic table of transition metals in Groups 4-10 and a halide which is an element of Group 17. Then there is an additional additive which contains a metal which is magnesium from group 2 and anthracene which contains an one or more elements of group 14 which is carbon and additional there is hydrogen. Therefore there are two components that are being claimed in US 6,117,372 and they meet the requirement of the two components being claimed in the instant invention . US 6,117,372 reads on the rejected claims and newly added claim. Also the magnesium chloride would fit for an element of Group 17 and Group 2 and still reads on the additive for all claims but 25. This additive is being claimed and would, by its presence, increase the activity according to the claim language. It is unclear what exactly is being argued as to why this no longer meets the requirements. There are two different components a transition metal component and and magnesium anthracene compound or a magnesium chloride. The transition metal component 1 is met by the claims in US 6,117,372 and the second component. Mg anthracene or or $MgCl_2$ meets the requirements of the second component (i.e. metal from Group 2 and either hydrogen and carbon (Group 14 anthracene)) or (i.e. metal from Group 2 and group 17 $Mg Cl_2$ -excluding claim 25). Although these are also called cocatalysts

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they do not preclude them from also being activators since they fall within the limitations of the second metal component.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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7. Claims 1-9, 15-21 and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 11-12 of U.S. Patent No. 6,221,285. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant invention is claiming a process for preparing Grignard compounds reacting an organic halide and magnesium metal with a transition metal catalyst (the metal from Groups 3-11 and the other component from Groups 14-17 and a second component that comprises an element from Groups 1, 2, or 3 and an element from Groups 14-17 which has an ethereal solvent (selected from tetrahydrofuran, monoglyme or diglyme) whereas US 6,221,285 claims a process for preparing Grignard compounds comprising reacting an organic halide with magnesium metal in the presence of a transition metal catalyst that comprises a transition metal from Groups 3-11 and as second component to the transition metal from groups 15 or 16 and a cocatalyst of an aromatic magnesium compound which is within the cocatalyst structures being claimed found in claim 3 (i.e. Group 2 with Group 14) which has an ethereal solvent (selected from tetrahydrofuran, monoglyme or diglyme). This meets the limitation of the process being claimed in the instant invention. US 6,221,285 may call Magnesium anthracene and/or Mg Cl₂ a co catalyst but it fits the limitation of a compound of group 2 with an element of Hydrogen and elements from Groups 14-17 and therefore reads on the materials being claimed as a second component. Also when the magnesium anthracene and the Mg Cl₂ are together one could be considered a second component and the other a cocatalyst. No matter what they are called they fit within the limitation of what is being claimed in the

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instant invention. It is also noted that although the formation of the magnesium is not specifically taught is is common to scrap or cut the magnesium etc to expose pure surfaces and give more active surface area. This is commonly known in the art. There is an large overlap in the claims and the instant invention is an obvious variant of the claimed invention of US 6,221,285.

8. Claims 10-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

There is no teaching to use an organomagnesium halide as an additional catalyst component.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr J F Vollano whose telephone number is (703) 305-4483. The examiner can normally be reached on Monday to Thursday from 6:30 to 5:00 .

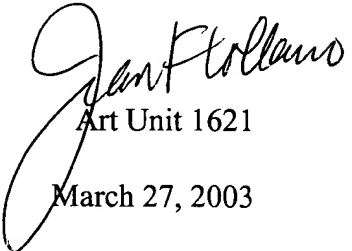
10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter , can be reached on (703)308-4532 . The official fax phone number for the organization where this application or proceeding is assigned is (703)308-4556. It should be noted that the examiner cannot immediately work on a fax sent to this number.

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11. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1235.

Jean F. Vollano

Primary Examiner



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March 27, 2003